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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,815	09/08/2003	Methvin Isaac	317743-121	1150
25561	7590	10/05/2004	EXAMINER	
JOHN W. RYAN C/O DECHERT LLP PRINCETON PIKE CORPORATION CENTER P.O. BOX 5218 PRINCETON, NJ 08543-5218			DENTZ, BERNARD I	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/657,815

Applicant(s)

ISAAC ET AL.

Examiner

Bernard Dentz

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 at p. 108 sets out the possible substituents on Ar1= optionally substituted phenyl. Then at the bottom of the page it provisos out certain substituents attached to the 2-position. The third through eighth of said excluded substituents are not embraced by the "possible substituents". Only nitro, haloalkyl( included because alkyl may be further substituted with halo) and the  $-S(O)_2NR_{12}R_{13}$  group are included.

Alkanoyl is not included as a value for Rb. Thus the second proviso in claim 1 and acetyl in claim 2 are improper. "Ra" in claim 2 should be Rb. R6 in claims 3 and 4 should be Rb.

The value trifluoromethyl in claim 11 does not have basis in claim 10 from which it depends. The same holds for claim 12.

Species 6 and 7 in claim 13 have a 2-nitro substituent which has been excluded from claim 1 from which it depends.

Restriction is required between the following distinct and independent inventions:

I. R1 is cycloalkyl or aryl; R2 and R3 do not form a ring with the C to which they are attached as in claims 1-6 and 8-11 and 13-16 classified in Class 564, sub-class 50 e.g..

II. R1 is as above and R2 and R3 form a ring with the C to which they are attached as in claims 1-6, 8, 9 and 12 and 14-16, classified in Class 564, Sub-class 49 e.g..

III. R1 is heterocycloalkyl or heteroaryl and R2 and R3 are as in I as in claims 1-5, 7, 10, 11 and 13-16, classified in Class 549 sub-class 77 e.g.

IV. R1 is as directly above and R2 and R3 are as in II as in claims 1-5, 7, 12 and 14-16, classified in class 546 sub-class 305 e.g.

The inventions are distinct, each from the other because:

The above groups are patentably distinct because of their widely diverse structure and would support separate patents. The instant claims, especially claims 1-3, 5 and 8-11 are anticipated as gleaned by the examiner from a preliminary online search of Chemical Abstracts. The above Groups are searched in separate areas. Thus restriction as above is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Dentz whose telephone number is 571-272-0683. The examiner can normally be reached on Mon-Fri from 8 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Dentz

9-30-2004

  
EDWARD DENTZ  
PRIMARY EXAMINER  
GROUP 1600